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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte
JAIME L. RUGNETTA, MARY S. WENTORF, GREGORY R. LEY, CHRISTOPHER M. ZERBY, LYLE A. BYE, PAUL E. ZAREMBO, BRIAN D. SOLTIS, and JEFFREY T. BARTIG

Appeal 2008-1771
Application 10/670,985
Technology Center 3700

Decided: July 10, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a lead assembly for use in implantation of electrodes. We have jurisdiction under 35 U.S.C. § 6(b). We affirm in part.

Background

"[E]lectrodes implanted in or about the heart have been used to reverse certain life threatening arrhythmias, or to stimulate contraction of the heart, where electrical energy is applied to the heart via the electrodes to return the heart to normal rhythm" (Spec. 2). The Specification comments that "electrodes are often fixated within passages or within chambers of the heart through use of one or more tines which extend from the lead body" (Spec. 2).

Statement of the Case

The Claims

Claims 1-20 are on appeal. We will focus on claims 1, 2, 3, 4, 7, and 8 which are representative and read as follows:

> 1. A lead assembly comprising:
>
> a lead body extending from a lead proximal end to a lead distal end and having an intermediate portion therebetween, the lead body including a tine interface section;
>
> at least one tine coupled with the lead body at a tine coupling portion, each at least one tine having a top surface and a bottom surface, the at least one tine having a first position extended away from the lead body, the at least one tine having a second collapsed position;
>
> at least one first recessed portion formed on the lead body at a first longitudinal location along the tine interface section of the lead body;
>
> at least one second recessed portion formed on the lead body at a second longitudinal location along the tine interface section of the lead body;
>
> the at least one first recessed portion longitudinally disposed between the tine coupling portion and the at least one second recessed portion; and
>
> wherein the at least one first recessed portion is recessed away from the bottom surface of the at least one tine when the at least one tine is disposed in the second collapsed position.

2. The lead assembly as recited in claim 1, wherein the at least one first recessed portion extends only a portion around a perimeter of the lead body.

3. The lead assembly as recited in claim 1, wherein the lead body has a first cross-sectional area at the at least one first recessed portion, and the lead body has a second cross-sectional area at the at least one second recessed portion, and the first cross-sectional area is smaller than the second cross-sectional area.

4. The lead assembly as recited in claim 1, wherein the lead body has a first cross-sectional area at the tine interface section, and the lead body has a second cross-sectional area at a second area between the at least one tine and the lead distal end, and the first cross-sectional area is less than 10% smaller than the second cross-sectional area.

7. The lead assembly as recited in claim 1, wherein the intermediate portion of the lead body has a first cross-section, the first recessed portion has a second cross-section, and the second recessed portion has a third cross-section, and the first cross-section, the second cross-section, and the third cross-section are each different from one another.

8. A lead assembly comprising:

a lead body extending from a lead proximal end to a lead distal end and having an intermediate portion therebetween, the lead body having a tine interface section;

at least one tine coupled with the lead body at a tine coupling portion, each at least one tine having a top surface and a bottom surface, the at least one tine having a first position extended away from the lead body, the at least one tine having a second collapsed position;

at least one first portion formed on the lead body at a first location along the tine interface section of the lead body, the at least one first portion having a first cross-sectional shape;

at least one second portion formed on the lead body at a second location along the tine interface section of the lead body, the at least one second portion having a second cross-sectional shape;

the first cross-sectional shape is different than the second cross-sectional shape; and

the at least one first portion longitudinally disposed between the tine coupling portion and the at least one second portion.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Huepenbecker	U.S. 6,289,251	Sep. 11, 2001
Laske	U.S. 5,807,399	Sep. 15, 1998
Alferness	U.S. 5,531,781	Jul. 2, 1996

The issues

The rejections as presented by the Examiner are as follows:

A. Claims 1, 3-4, 6-10, 12, 14-16, and 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Huepenbecker (Ans. 3).

B. Claims 1, 3-4, 6-10, 12, 14-16, and 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Laske (Ans. 5).

C. Claims 2, 5, 11, 13, and 17-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over Huepenbecker and Alferness (Ans. 7).

D. Claims 2, 5, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Laske (Ans. 8).

E. Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being obvious over Laske and Alferness (Ans. 9).

A. 35 U.S.C. § 102(b) rejection over Huepenbecker

Appellants argue that they

> cannot find in Huepenbecker et al. a recessed portion recessed away from the bottom surface of the tine when the tine is disposed in the second collapsed position, as recited in claims 1 and 14, or forming a first recessed portion along the lead body along the tine interface portion including recessing the first recessed portion away from the bottom surface when the one or more tines are disposed in the second collapsed position, as recited in claim 15. Appellant further cannot find in the reference the first portion along the tine interface second having a first cross-sectional shape that is different than a second cross-sectional shape, as recited in claim 8.

(App. Br. 12.) Appellants contend that they "cannot find in Huepenbecker et al. or any of the cited references discussion related to the tines being recessed away from a first recessed portion. Appellant respectfully submits that Huepenbecker et al. does not enable such statements" (App. Br. 13).

The Examiner responds that "[a]lthough not explicitly stated in Huenpenbecker, [sic] passive tines such as the ones illustrated in Huenpenbecker [sic] are necessarily are formed of a flexible material such that the tines fold/collapse against the lead body during insertion into the patient" (Ans. 13). The Examiner argues that "[i]n order to implant the lead distal end at the heart such that it can provide the desired pacing or defibrillation therapy, the tines necessarily must fold down/collapse against the lead body such that the lead can be tracked through a patient's vasculature system to the implantation site" (Ans. 14).

The Examiner also contends that "[s]ince cross-sectional area is a direct function of diameter size, Examiner maintains that the cross-sectional area of the first recessed portion must necessarily be smaller than the cross-sectional area of the second recessed portion" (Ans. 14).

The Examiner also argues that "[s]ince the axial view of Figure 4 shows the diameter of the first recessed portion to be smaller than the diameter of the second

recessed portion, Examiner considers the cross-sectional area of the first recessed portion to be different from the second cross-sectional shape" (Ans. 15).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

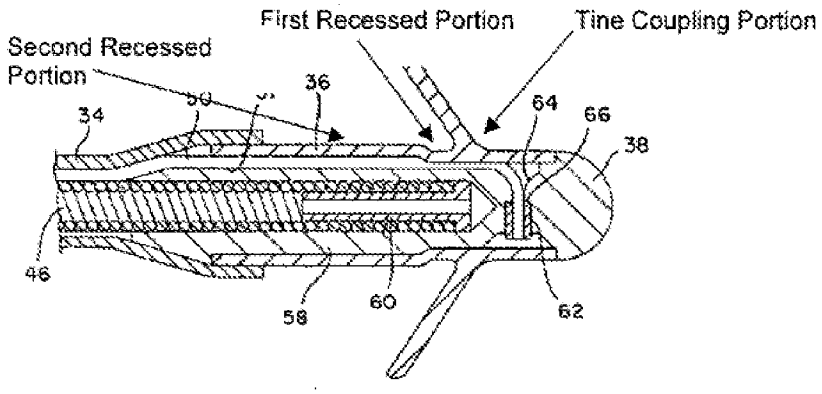
Does the lead assembly of Huepenbecker satisfy the limitations of claims 1, 3, 4, 7, and 8?

Findings of Fact

1. Huepenbecker teaches that a "lead is provided with an elongated insulative lead body **10**, which terminates at its proximal extremity in a molded bifurcation member **12**" (Huepenbecker, col. 2, ll. 36-38).

2. Huepenbecker teaches that the "lead is optionally provided with tines **40** to assist in acute fixation of the electrode **38** in the right ventricular apex" (Huepenbecker, col. 2, ll. 57-59).

3. Huepenbecker discloses that the lead body has first and second recessed portions as shown by Figure 4 of Huepenbecker as annotated by the Examiner shown below:



The annotated figure 4 of Huepenbecker above shows the locations of the first and second recessed portions (*see* Ans. 3).

4. Huepenbecker discloses a cross-section of figure 4 in which a first recessed portion is smaller than a second recessed portion (*see* Huepenbecker, Fig. 4; Ans. 3).

Discussion of 35 U.S.C. § 102(b) over Huepenbecker

Claim 1

We conclude that the Examiner has set forth a prima facie case that claim 1 is anticipated by Huepenbecker. Huepenbecker teaches a lead body (FF 1) with tines (FF 2) as well as two regions which form recessed portions into which the tines would fold if the tines of Huepenbecker were collapsed (FF 3).

Appellants contend that they "cannot find in Huepenbecker et al. or any of the cited references discussion related to the tines being recessed away from a first recessed portion. Appellant respectfully submits that Huepenbecker et al. does not enable such statements" (App. Br. 13).

We do not find this argument persuasive because the plain language of Huepenbecker indicates that the tines are sometimes recessed (*see* FF 2). Specifically, Huepenbecker teaches that the "lead is optionally provided with tines **40** to assist in acute fixation of the electrode **38** in the right ventricular apex" (Huepenbecker, col. 2, ll. 57-59). The teaching by Huepenbecker that the tines are used for "acute fixation" inherently requires that the tines must be capable extending from a collapsed position and fixing the electrode in place (*see* FF 2). Otherwise, if the tines were constantly extended, they would not function in "acute fixation" but would rather cause constant fixation. Thus, the specific language used by Huepenbecker is inconsistent with Appellants' argument since the tines of Huepenbecker necessarily operate to collapse when not assisting in "acute fixation" and extend when performing "acute fixation (*see* FF 2). *See, e.g., Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1347 (Fed.

Cir.1999) ("Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.")

We are also not persuaded by Appellants' argument that they "cannot find in Huepenbecker et al. a recessed portion recessed away from the bottom surface of the tine when the tine is disposed in the second collapsed position" (App. Br. 12). We agree with the Examiner that

> [w]hen the tines collapse during implantation, the first recessed portion would necessarily be recessed away from the bottom surface of the tine because the bottom surface of tines would contact the outer surface of sleeve 36 (which forms the second recessed portion), thus leaving the first portion (which is illustrated as smaller in cross-section than the second recessed portion) recessed away from the bottom surface of the tine.

(Ans. 14.) In our opinion, figure 4 shows that when the tines are recessed, the tines will have a first recessed region that is recessed away from the bottom surface of the tine when the tines are collapsed (*see* FF 3). We find that this disclosure of Huepenbecker suffices to anticipate the elements of claim 1.

Claim 3

Appellants assert "that one skilled in the art could not determine the cross-sectional areas of what the Final Office Action identifies as the first and second recessed portions of Huepenbecker et al. given only a cross section along a single axial plane" (App. Br. 13). Appellants also argue that the skilled artisan would not be "able to identify the widths of what the Final Office Action identifies as the first and second recessed portions of Huepenbecker et al. as being diameters" (App. Br. 13).

In analyzing claim 3, our mandate is to give claims their broadest reasonable interpretation.

> Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.' *Yamamoto*, 740 F.2d at 1571; *accord Hyatt*, 211 F.3d at 1372; *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989) ('An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.').

In re American Academy of Science Tech Center, 367 F.3d 1359, 1364, (Fed. Cir. 2004). Claim 3 recites that the "first cross-sectional area is smaller than the second cross-sectional area". As plainly interpreted, the claim does not require that all cross-sections from the lead assembly result in a smaller first than second cross-sectional area, only that at least a first and second cross-sectional area meet this requirement. However, Appellants' argument, in essence, is that the single cross-section from Figure 4 of Huepenbecker does not demonstrate that all cross-sectional areas in Figure 4 would satisfy the requirements of claim 3. We conclude that the claim only requires one cross section of the lead assembly that must have a first area smaller than the second cross-sectional area. We find that the cross-section disclosed by Huepenbecker in Figure 4 satisfies the requirement of claim 3 (FF 4) so that Huepenbecker anticipates claim 3.

Claim 4

As discussed above with regard to claim 3, Huepenbecker discloses a cross-section in Figure 4 which discloses both a first and second cross-section at the tine interface (FF 4). Appellants submit "that because the patent drawings of Huepenbecker et al. do not define the precise proportions of the elements and because Appellant cannot find discussion in the specification regarding the issue, the figures of

Huepenbecker et al. may not be relied on to show particular sizes to anticipate claim 4" (App. Br. 14).

The Examiner contends that "[f]igure 4 illustrates that the cross-sectional area at the lead distal end (between electrode 38 and the tine- coupling portion) is approximately the same as the cross-sectional area of the tine-coupling portion" (Ans. 15).

We agree with Appellants that Figure 4 of Huepenbecker cannot be relied upon for the specific ratio of the first and second cross-sectional areas where the first cross-sectional area "is less that 10% smaller than the second cross-sectional area" (Claim 4). "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). *See In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.")

Since Huepenbecker provides no quantitative arguments in the disclosure, we reverse the rejection of claim 4 over Huepenbecker.

Claims 7 and 8

In analyzing claims 7 and 8, our mandate is to give these claims their broadest reasonable interpretation. *See In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Claim 7 requires that "the first cross-section, the second cross-section, and the third cross-section are each different from one another" (Claim 7). Claim 8 similarly requires that the "first cross-sectional shape is different than the second cross-sectional shape" (Claim 8). We interpret these claims broadly

to simply require that the cross-sections differ, without any regard for any specific quantitative level of difference.

Given this interpretation and Figure 4 of Huepenbecker, we find that each of the cross sections in Huepenbecker differ from one another (*see* Huepenbecker, fig. 4). While specific values for the differences cannot be derived from the figure, as discussed above regarding claim 3, we think the figure reliably shows that the first, second and third cross-sections differ in size. *See In re Wolfensperger*, 302 F.2d 950, 959 (CCPA 1962)("We find nothing therein, however, which raises a presumption . . . that four enlarged detailed figures consistently showing the same relative proportions must be ignored.")

We therefore affirm the rejection of claims 7 and 8 over Huepenbecker since each of the cross-sections differs from one another.

We affirm the rejection of claims 1, 3, 7 and 8 under 35 U.S.C. § 102(b) over Huepenbecker. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 6, 9, 10, 12, 14-16, and 19-20 as these claims were not argued separately.

We reverse the rejection of claim 4 under 35 U.S.C. § 102(b) over Huepenbecker.

B. 35 U.S.C. § 102(b) rejection over Laske

Appellants argue that they "cannot find in Laske et al. a recessed portion recessed away from the bottom surface of the tine when the tine is disposed in the second collapsed position, as recited in claim 1 and 14" (App. Br. 15). Appellants further argue that they "cannot find in the reference the first portion along the tine interface second having a first cross-sectional shape that is different that a second cross-sectional shape as recited in claim 8" (App. Br. 15).

Appellants also argue regarding claim 3 that

> one skilled in the art could not determine the cross- sectional areas of what the Final Office Action identifies as the first and second recessed portions of Laske et al. given only a cross section along a single axial plane, nor would one skilled in the art be able to identify the widths of what the Final Office Action identifies as the first and second recessed portions of Laske et al. as being diameters.

(App. Br. 16.) Appellants assert that "the drawings of Laske et al. cannot be used to anticipate claim 4, which recites 'the first cross-sectional area is less than 10% smaller than the second cross-sectional area'. That is, Appellant submits that because the patent drawings of Laske et al. do not define the precise proportions of the elements . . . [they] may not be relied on to show particular sizes" (App. Br. 17).

The Examiner responds that "tines such as the ones illustrated in Laske are necessarily are formed of a flexible material such that the tines fold/collapse against the lead body during insertion into the patient" (Ans. 18). The Examiner further contends that

> [w]hen the tines collapse during implantation, the first recessed portion would necessarily be recessed away from the bottom surface of the tine because the bottom surface of tines would contact the outer surface lead body (which forms the second recessed portion), thus leaving the first portion or groove 152 (which is illustrated as smaller in cross-section than the second recessed portion) recessed away from the bottom surface of the tine.

(Ans. 19.)

The Examiner also argues that "[s]ince cross-sectional area is a direct function of diameter size, Examiner maintains that the cross-sectional area of the first recessed portion must necessarily be smaller than the cross-sectional area of the second recessed portion" (Ans. 20).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the lead assembly of Laske satisfy the limitations of claims 1, 3, 4, 7, and 8?

Findings of Fact

5. Laske teaches that the "lead is provided with an elongated lead body which is covered with an insulation sheath" (Laske, col. 5, ll. 11-13).

6. Laske teaches that a "tine fixation mechanism **40** is immediately proximal to the exposed tip electrode **26** and includes tubular sheath **22** from which four tines **24** (three of which are visible) project out at an acute angle" (Laske, col. 5, ll. 26-29).

7. Laske teaches that the "[s]oft, pliant, tines **24** engage with heart tissue and urge tip electrode **26** into contact with the endocardium in a direction parallel to the lead axis" (Laske, col. 5, ll. 30-32).

8. Laske discloses that the lead body has first and second recessed portions as shown by Figure 5 of Laske as annotated by the Examiner shown below:

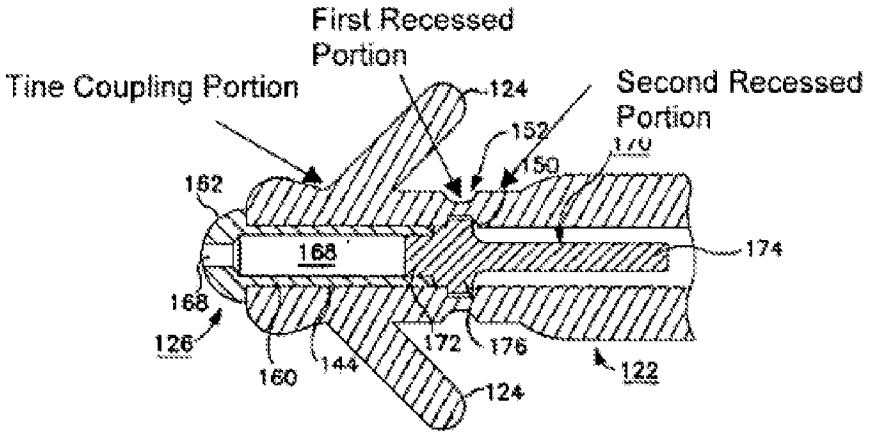


FIG. 5

The annotated figure 5 of Laske above shows the locations of the first and second recessed portions (*see* Ans. 5).

9. Laske discloses a cross-section of figure 5 in which a first recessed portion is smaller than a second recessed portion (*see* Laske, Fig. 5; Ans. 5).

Discussion of 35 U.S.C. § 102(b) over Laske

Claim 1

We conclude that the Examiner has set forth a prima facie case that claim 1 is anticipated by Laske. Laske teaches a lead body (FF 5) with tines (FF 6-7) as well as two regions which form recessed portions into which the tines would fold if the tines of Laske were collapsed (FF 8-9).

We are not persuaded by Appellants' argument that they "cannot find in Laske et al. a recessed portion recessed away from the bottom surface of the tine when the tine is disposed in the second collapsed position, as recited in claim 1 and 14" (App. Br. 15). We agree with the Examiner that

> [w]hen the tines collapse during implantation, the first recessed portion would necessarily be recessed away from the bottom surface of the tine because the bottom surface of tines would contact the outer surface lead body (which forms the second recessed portion), thus leaving the first portion or groove 152 (which is illustrated as smaller in cross-section than the second recessed portion) recessed away from the bottom surface of the tine.

(Ans. 19.) In our opinion, figure 5 of Laske shows that when the tines are recessed, the tines will have a first recessed region that is recessed away from the bottom surface of the tine when the tines are collapsed (*see* FF 8).

Appellants also argue that they "cannot find in Laske et al. or any of the cited references discussion related to the tines being recessed away from a first recessed portion. Appellant respectfully submits that Laske et al. does not enable such

statements" (App. Br. 15). In our opinion, this argument fails to appreciate the point of tines. If the tines were always extended, they would prevent the lead from being introduced into the endocardial tissue in the way described by Laske as "passage through a venous access" (Laske, col. 1, ll. 34-35). Therefore, the tines of Laske must inherently collapse when being placed through the veins, but be capable of fixation with "a plurality of tines projecting from the sheath" (Laske, col. 1, ll. 44-45).

We find that this disclosure of Laske suffices to anticipate the elements of claim 1.

Claim 3

Applying the same claim interpretation to claim 3 as discussed above, claim 3 does not require that all cross-sections from the lead assembly result in a smaller first than second cross-sectional area, only that at least a first and second cross-sectional area meet this requirement. We conclude that the claim only requires one cross section of the lead assembly that must have a first area smaller than the second cross-sectional area. We find that the cross-section disclosed by Laske in Figure 5 satisfies the requirement of claim 3 (FF 9) so that Laske anticipates claim 3.

Claim 4

The Examiner argues that "Figure 5 illustrates that the cross-sectional area at the lead distal end (between electrode 126 and the tine- coupling portion) is approximately the same as the cross-sectional area of the tine-coupling portion" (Ans. 20).

We agree with Appellants that Figure 5 of Laske cannot be relied upon for the specific ratio of the first and second cross-sectional areas where the first cross-sectional area "is less that 10% smaller than the second cross-sectional area" (Claim 4). "[I]t is well established that patent drawings do not define the precise proportions

of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). *See In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.")

Since Laske provides no quantitative arguments in the disclosure, we reverse the rejection of claim 4 over Laske.

Claims 7 and 8

As discussed above, Claim 7 requires that "the first cross-section, the second cross-section, and the third cross-section are each different from one another" (Claim 7). Claim 8 similarly requires that the "first cross-sectional shape is different than the second cross-sectional shape" (Claim 8). We interpret these claims broadly to simply require that the cross-sections differ, without any regard for any specific quantitative level of difference.

Given this interpretation and Figure 5 of Laske, we find that each of the cross sections in Laske differ from one another (*see* Laske, fig. 5). While specific values for the differences cannot be derived from the figure, as discussed above regarding claim 3, we think the figure reliably shows that the first, second and third cross-sections differ in size. *See In re Wolfensperger*, 302 F.2d 950, 959 (CCPA 1962)("We find nothing therein, however, which raises a presumption . . . that four enlarged detailed figures consistently showing the same relative proportions must be ignored.")

We therefore affirm the rejection of claims 7 and 8 over Laske since each of the cross-sections differs from one another.

We affirm the rejection of claims 1, 3, 7 and 8 under 35 U.S.C. § 102(b) over Laske. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 6, 9, 10, 12, 14-16, and 19-20 as these claims were not argued separately.

We reverse the rejection of claim 4 under 35 U.S.C. § 102(b) over Laske.

C. 35 U.S.C. § 103(a) rejection over Huepenbecker and Alferness

We have already concluded that Huepenbecker teaches the limitations of claim 1. Appellants argue that the "Final Office Action fails to provide a legally sufficient motivation to combine the references" (App. Br. 18). Specifically, Appellants contend that the motivations identified by the Examiner "are unsupported by the cited references" (App. Br. 18).

The Examiner specifically found that "Alferness et al. teaches a variety of embodiments in which a plurality of tines are received in a space or spaces formed within the lead body (see Figs. 6, 8, and 10 and corresponding text at col. 6, line 8 - col. 7, line 20)" (Ans. 7). The Examiner then concludes that one reason to combine the inventions is "to modify the first and/or second recessed portions of Huepenbecker et al. such that recesses are created only at the area in which the tines contact the lead body as taught by Alferness et al. in order to ensure that lead body is sufficiently strong during implantation" (Ans. 7).

We agree with the Examiner that claim 2 is obvious over Huepenbecker and Alferness. We find the Appellants' arguments unpersuasive. Precise teachings directed to the specific subject matter of a claim are not required to reach a conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). "[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references…. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006). In this case, the Examiner has provided a specific prior art reference, Alferness, which teaches that a "reduced diameter portion **107** of the guide tip **102** forms a space **109** for receiving the tines" (Alferness, col. 6, ll. 24-25). The Examiner has provided a specific common sense reason to apply Alferness's teaching to Huepenbecker, which is to minimize the risk of the lead breaking due to reduced diameter (*see* Ans. 7). In our opinion, this is sufficient motivation to combine the references and render the claims obvious.

We affirm the rejection of claim 2 under 35 U.S.C. § 103(a) over Huepenbecker and Alferness. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 5, 11, 13, and 17-18 as these claims were not argued separately.

D. 35 U.S.C. § 103(a) rejection over Laske

We have already concluded that Laske teaches the limitations of claim 1. Appellants argue that the "Final Office Action fails to provide a legally sufficient motivation to combine the references" (App. Br. 19). Specifically, Appellants contend that the motivations identified by the Examiner "are unsupported by the cited references" (App. Br. 19).

The Examiner specifically found that Laske "discloses a lead having two recessed portions at the tine interface section of the lead body" (Ans. 8). The Examiner recognizes that Laske does not teach "that the first recessed portion extends only a portion around the perimeter of the lead body" (Ans. 8). However, the Examiner contends that it would have been obvious to "modify the external groove 152 of Laske et al. such that it only extends around a portion of the perimeter of the lead body . . . in order to ensure that sheath 122 is sufficiently strong during implantation" (Ans. 8-9).

We agree with the Examiner that claim 2 is obvious over Laske and find the Appellants' arguments unpersuasive. Precise teachings directed to the specific subject matter of a claim are not required to reach a conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). "[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references…. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006). In this case, the Examiner has provided a specific common sense reason to control the groove size of Laske, which is to minimize the risk of the lead breaking due to a reduced diameter (*see* Ans. 8-9). In our opinion, this is sufficient motivation to modify the reference and render the claims obvious.

We affirm the rejection of claim 2 under 35 U.S.C. § 103(a) over Laske. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 5, 11, and 17 as these claims were not argued separately.

E. 35 U.S.C. § 103(a) rejection over Laske and Alferness

We have already concluded that Laske anticipates claim 1, as discussed above and that Alferness teaches that a "reduced diameter portion **107** of the guide tip **102** forms a space **109** for receiving the tines" (Alferness, col. 6, ll. 24-25). We therefore do not find persuasive Appellants' argument that Laske and Alferness lack the elements necessary to render claims 13 and 18 obvious (*see* App. Br. 20).

We agree with the Examiner that claims 13 and 18 are obvious over Laske and Alferness. We find the Appellants' arguments regarding the absence of motivation unpersuasive (*see* App. Br. 20). Precise teachings directed to the specific subject matter of a claim are not required to reach a conclusion of obviousness. *KSR Int'l Co. v.*

Teleflex Inc., 127 S. Ct. 1727, 1741 (2007). "[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references…. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006). In this case, the Examiner has provided a specific prior art reference, Alferness, which teaches that a "reduced diameter portion **107** of the guide tip **102** forms a space **109** for receiving the tines" (Alferness, col. 6, ll. 24-25). The Examiner has provided a specific common sense reason to apply Alferness's teaching to Laske, which is to "ensure that sheath 122 is sufficiently strong during implantation" (*see* Ans. 10). In our opinion, this is sufficient motivation to combine the references and render the claims obvious.

We affirm the rejection of claims 13 and 18 under 35 U.S.C. § 103(a) over Laske and Alferness.

CONCLUSION

In summary, we affirm the rejection of claims 1, 3, 7 and 8 under 35 U.S.C. § 102(b) over Huepenbecker. We affirm the rejection of claims 1, 3, 7 and 8 under 35 U.S.C. § 102(b) over Laske. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 6, 9, 10, 12, 14-16, and 19-20 as these claims were not argued separately. We also affirm the rejection of claim 2 under 35 U.S.C. § 103(a) over Huepenbecker and Alferness. We also affirm the rejection of claim 2 under 35 U.S.C. § 103(a) over Laske. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 5, 11, 13, and 17-18 as these claims were not argued separately. We affirm the rejection of claims 13 and 18 under 35 U.S.C. § 103(a) over Laske and Alferness.

We reverse the rejection of claim 4 under 35 U.S.C. § 102(b) over Huepenbecker. We reverse the rejection of claim 4 under 35 U.S.C. § 102(b) over Laske.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED IN PART

cdc

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